

REMARKS

In order to expedite prosecution, independent claims 1, 8 and 19 have been amended, without prejudice/disclaimer to the subject matter embodied thereby, to incorporate the subject matter of claim 2. Claims 24 and 25 have similarly been rewritten into independent form. Accordingly, all pending rejections have been rendered moot except for the rejection under 35 U.S.C. § 103 over Kikuchi in view of Sekiyama or Elrod.

A certified English translation of the foreign priority document for the present application (i.e., JP 2000-111731, filed April 13, 2000) is attached hereto to perfect Applicants' claim to foreign priority. Accordingly, it is respectfully submitted that Elrod is not prior art to the present application because its earliest effective date is November 22, 2000.

As previously argued, it is respectfully submitted that none of the cited prior art discloses or suggests wherein step (b) is performed based on a change over time in the output signal as now recited in claims 1, 8, 19, 24 and 25. Rather, Sekiyama at best disclose *discrete* measurements of light to verify the amount of fluid held in the container, rather than a change over time of the light measurement. For example, in Sekiyama, the laser sensor detects when the liquid level reaches a desired line (*see* col. 12, line 18 – col. 13, line 50 of Sekiyama).

The Examiner maintains the pending rejections on the allegation that Sekiyama can monitor and maintain liquid levels and therefore reads on the claimed invention (*see* continuation page of outstanding Advisory Action). As a preliminary matter, the Examiner does not point to any location of Sekiyama to support his position as required. In any event, even assuming *arguendo* the Examiner's position is correct, it should be noted that multiple discrete measurements over time as would be the case in Sekiyama would each be independent from one another and therefore would not be a basis for verifying that a predetermined amount of solution

is held *at a given point in time*. That is, multiple discrete measurements does not necessitate that the change over time *itself* would be used for verification. Rather, each time the liquid level is “monitored and maintained” in Sekiyama would be based on a discrete measurement taken at the respective time. The fact that plural measurements taken at plural times will evidence a change over time of the liquid level is NOT tantamount to the liquid level at a give point in time being verified based on a change over time of the output signal.

In this regard, it is respectfully submitted that the Examiner must interpret the claims in view of Applicants’ specification. Though it is understood that limitations from the specification are not to be read into the claims, the specification can be used as a dictionary to define the terms used in the claims. In the instant case, it is respectfully submitted that the Examiner’s interpretation of “over time” as set forth in the particular manner in the pending claims conflicts with Applicants’ specification. Specifically, both the detected output signal “S” at a given time and *the change over time of “S” (i.e., dS/dt)* can be used *together* as parameters (opposed to multiple discrete measurements of just “S” as in Sekiyama) to confirm the verification to ensure that bubbles, etc., do not influence the measurement (see, e.g., page 18, lines 15 – 23 of Applicants’ specification). In light of Applicants’ specification, it is respectfully submitted that the Examiner’s interpretation of “over time” as used in the claims is improper, and that none of the cited prior art discloses or suggests using dS/dt as a parameter for verification at a given point in time. At best, the cited prior art’s “monitoring and maintaining” as asserted by the Examiner uses plural “S” measurements.

In any event, in order to further expedite prosecution and obviate the Examiner’s broad interpretations, the independent claims 1, 8 and 19 have been amended to incorporate the feature of claim 2 in which a specified manner of verification over time is recited to clearly distinguish

over simple plural, independent measurements over time as relied on by the Examiner. Indeed, the Examiner does not specifically identify any portions of the cited prior art which allegedly disclose the feature recited in claim 2. Claims 24 and 25 include similar features.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in the pending claims because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1, 8 and 19 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Having fully and completely responded to the Office Action, Applicant submits that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Ramyar M. Farid
Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 RMF:MWE
Facsimile: (202) 756-8087
Date: August 7, 2006